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Paper No. 7

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**OFFICE OF PETITIONS**

In re Application of	:
THOMAS HOFFMANN	:DECISION DISMISSING PETITION
Application No. 10/056,524	:UNDER 37 CFR 1.137(f)
Filed: January 23, 2002	:
Attorney Docket No. 3818.01-1	:

This is a decision on the petition under 37 CFR 1.137(f),<sup>1</sup> filed September 30, 2002, to revive the above-identified application.

The petition is **dismissed** as inappropriate for the reasons stated below.

The record discloses that, on January 23, 2002, the date of filing of the instant application, a Request and Certification under 35 U.S.C. § 122(b)(2)(B)(i) was filed certifying that "the invention disclosed in this **application has not and will not be** the subject of an application filed in another country, or under a multilateral international agreement, that requires publication at eighteen months after filing of the application."

Petitioner now requests under 35 U.S.C. § 122(b)(2)(B)(ii) that the Request and Certification Under 35 U.S.C. § 122(b)(2)(B)(i) be rescinded because an international application was filed on January 23, 2002, and that the application be revived under the provisions of 37 CFR 1.137(f). Petitioner states that "the filing of the Request for Non-publication was unintentional and apparently happened

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<sup>1</sup> 37 CFR 1.137(f) provides for revival of a nonprovisional application which became abandoned pursuant to the provisions of 35 U.S.C. § 122(b)(2)(B)(iii) for failure to timely notify the Office of the filing of an application in a foreign country or under a multinational treaty that requires publication of applications eighteen months after filing.

because originally Applicant considered filing only a US application with no corresponding foreign filing. Shortly before the due date for filing the full application, the Applicant decided to also file the PCT application. The filing documents for the US application were already prepared and by oversight the Request for Non-publication was left in the filing documents."

The instant nonprovisional application did not become abandoned as a result of the filing of a corresponding application filed in another country, or under a multilateral agreement, **subsequent** to the filing of the present application. In this regard, 35 U.S.C. § 122(b)(2)(B)(iii) states:

An applicant who has made a request under clause (i) but who **subsequently files, in a foreign country or under a multilateral international agreement** specified in clause (i), an application directed to the invention disclosed in the application filed in the Patent and Trademark Office, shall notify the Director of such filing not later than 45 days **after the date of the filing of such foreign or international application**. A failure of the applicant to provide such notice within the prescribed period shall result in the application being regarded as abandoned, unless it is shown to the satisfaction of the Director that the delay in submitting the notice was unintentional [emphasis supplied].

The facts of this case are that the subject application was filed on January 23, 2002, and the corresponding foreign application was also filed on January 23, 2002. The statute does not provide for the situation where a certification under 35 U.S.C. § 122(b)(2)(B)(i) was made, despite the fact that an application was previously filed in another country or under the multilateral international agreement. In view of petitioner's statement that the corresponding foreign application was filed on January 23, 2002, the same date as the filing of the subject application, the filing of the corresponding foreign application cannot be considered to have been filed **subsequent** to the filing of the subject application in the United States. The statute at 35 U.S.C. § 122(b)(2)(B)(iii) only provides for revival in the situation where a certification was made under 35 U.S.C. § 122(b)(2)(B)(i) at the time of filing the application and an application was **subsequently** filed in a foreign country without notifying the Office within 45 days of the filing thereof.

Since the corresponding foreign or international application was filed on the same date as the subject application, this application did not become abandoned pursuant to the provisions of 35 U.S.C. § 122(b)(2)(B)(iii). Therefore, a petition to revive

pursuant to the provisions of 37 CFR 1.137(f) is inappropriate and, consequently, must be dismissed.<sup>2</sup>

As requested, the Request and Certification Under 35 U.S.C. § 122(b)(2)(B)(i) has been rescinded. A corrected Filing Receipt indicating the projected date of publication of February 13, 2003 accompanies this decision.

The rules and statutory provisions governing the operations of the U.S. Patent and Trademark Office require payment of a fee on filing each petition. See 35 U.S.C. § 41(c)(7). Accordingly, the \$640 petition fee submitted is not refundable.

This application is being forwarded to Technology Center AU 1615 for appropriate action on the amendment filed July 29, 2002.

Any inquiries concerning this decision may be directed to the undersigned at (703) 305-8680.



Frances Hicks

Petitions Examiner  
Office of Petitions  
Office of the Deputy Commissioner  
for Patent Examination Policy

ATTACHMENT: Corrected Filing Receipt

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<sup>2</sup> Note [www.USPTO.gov](http://www.USPTO.gov), American Inventor's Protection Act of 1999 - Questions & Answers, CQ6.